



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/517,904

12/10/2004

Jianhua Feng

1-32526A/FMI

4693

1095

7590

11/12/2008

NOVARTIS  
CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 104/3  
EAST HANOVER, NJ 07936-1080

EXAMINER

MACAULEY, SHERIDAN R

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

11/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/517,904</p>	<p><b>Applicant(s)</b> FENG ET AL.</p>	
	<p><b>Examiner</b> SHERIDAN R. MACAULEY</p>	<p><b>Art Unit</b> 1651</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 09 October 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,3,5,7 and 8.  
Claim(s) withdrawn from consideration: 10-22.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: See Continuation Sheet.

/Ruth A. Davis/  
Primary Examiner, Art Unit 1651

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments have been considered, but they have not been found to be persuasive. For instance, regarding the rejection under 35 USC 102(b) as being anticipated by Matsuzaki when taken in view of Toker, applicant argues that it is unclear how the cited references anticipate the following claims. However, this information is set forth in the previously mailed office action and is as follows: Matsuzaki teaches a purified kinase. Toker teaches that the PBK/Akt has PKB Ser 473 kinase activity when associated with cellular proteins. Matsuzaki therefore anticipates the composition of the cited claims and Toker is relied upon for its teaching of the inherent PKB Ser 473 kinase activity. Further, although the references may not teach the apparent molecular weight of the protein, it is argued in the previous office action that the composition of Matsuzaki appears to be identical to the claimed composition and thus would inherently possess the claimed molecular weight. Furthermore, the molecular weight as recited in the examined claims is unclear; as noted in the previous action, it is unclear whether applicant is claiming that the composition comprises a protein which has (a) PKB Ser 473 kinase activity and an apparent molecular weight of 450-650 when it is associated with cellular proteins; or (b) PKB Ser 473 kinase activity when associated with cellular proteins, and an apparent molecular weight of 450-650 kDa. Thus, the association with other proteins to arrive at the claimed apparent molecular weight would inherently occur in vivo; a complexed protein is not required by the claim. Also, although applicant argues that the evidence in the prior art demonstrates that the cited protein does not possess the claimed characteristics, it is noted that the claim recites a composition comprising a protein that may be associated with other proteins, and possessing a specific characteristic. Therefore, even if it is unclear which protein in the Matsuzaki reference possesses the claimed characteristic, the composition as a whole does possess the characteristic, and thus it meets the limitation of the claim. Therefore, applicant's arguments have not overcome the rejection.

Continuation of 13. Other: The proposed amendments will not be entered because they raise new issues that would require further consideration and/or search. For instance, the limitation "cell-free" and limitation wherein the claim recites a composition comprising a complexed protein were not recited in the previously examined claims. These new limitations would necessitate an thorough examination of the cited prior art as related to the claims and as well as a new search.